

App. Serial No. 10/865,695
Docket No.: DE 030200 US

Remarks

The Office Action dated November 29, 2006 indicated that claims 1-6 and 9 stand rejected under 35 U.S.C. § 103(a) over Chari *et al.* (U.S. 4,428,046) in view of Dean (U.S. 4,641,375); and claim 7-8 are indicated as potentially allowable, if rewritten in independent form to include limitations of any intervening claims.

Applicant appreciates the indication of allowability for claims 7 and 8.

Applicant traverses the Section 103(a) rejections of claims 1-6 and 9, because the Office Action fails to provide correspondence for each and every claimed limitation. The Office Action fails to provide adequate evidence of motivation to suggest that the skilled artisan would modify the Chari reference with the teachings from the Dean reference because the asserted modification of the Chari in view of the Dean would frustrate the purpose of the Chari reference and because the references teach away from the attempted modifications. According to the M.P.E.P. § 707.7(f) as further explained below, because the asserted modification would frustrate the purpose of the main reference, the rejection is improper.

The Examiner's asserted definition for a pilot signal is "a signal transmitted over a communication system for control or reference purposes" (*see, e.g.*, the instant Office Action, page 3, lines 2-3). Applicant appreciates the Examiner's clarification of the rationale behind the asserted definition, but respectfully submits (without expressing an opinion as to the validity of the asserted definition) that this rationale is moot in view of the claimed limitations. More specifically, the claimed limitations are explicitly directed to a pilot signal of varying frequency. The Examiner admits that the Chari reference does not teach such a varying frequency component and attempts to address this deficiency using the teachings of the Dean reference.

Applicant appreciates the Examiner's clarification regarding the asserted motivation to combine the Chari and Dean references; however, in attempting combine the references, it appears that the Examiner has ignored important functional details. In doing so, the Office Action fails to address Applicant's previous arguments that such a combination would be inoperable for its state purpose (provided in Applicant's response dated August 16, 2006) as required by MPEP 707.7(f). The Chari reference teaches a star coupler

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having circuitry for resolving contention among messages arriving at the star coupler (see Col. 2, lines 24-39). The Examiner relies upon the Chari reference's contention circuitry 42 in the asserted correspondence to various aspects of the claimed invention. Table 1 of the Chari reference shows part of the contention circuit's functionality in response to flag bits 0-7. Thus, the contention control circuit taught by Chari is reliant upon receipt of the flag bits to resolve collisions. In contrast, the Dean reference teaches that collisions are detected via a RETURN fiber by circuits at each MAU (see Col. 2, lines 9-40). The RETURN fiber is taught to carry a signal representing sharing of received signals (see Col. 3, lines 22-25). Applicant submits that were the flag bits of the Chari reference to be replaced with the pilot signals of the Dean reference as proposed, the Chari contention circuit 42 would fail to detect collisions. More specifically, the Dean reference teaches that collision detection is accomplished by each MAU monitoring the RETURN fibers rather than decoding flag bits using contention circuitry at the star coupler.

Moreover, the contention circuitry of the Chari reference is located at the star coupler. The Dean reference teaches that each MAU detects the collision on RETURN fibers. Thus, because neither reference teaches or suggests (alone or in combination) a circuit capable of using the pilot signals of the Dean reference to detect collisions at the star coupler of the Chari reference, Applicant submits that the combination of varying frequency pilot signals and the contention circuitry of the Chari reference would render the circuit of the Chari reference inoperable for resolving contention among messages. In view of the above discussion, it is unclear how the proposed combination could be made to function. Should the Examiner wish to provide further details of the proposed combination and the motivation to implement such details, Applicant would appreciate an opportunity to respond.

As consistent with relevant case law and the M.P.E.P., there is no motivation to modify a reference where the modification would undermine or defeat the purpose of the reference (see, e.g., *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). An object of the Chari reference is to resolve contention among messages arriving from different subsystems (see Col. 2, lines 24-39). In view of the above discussion, Applicant submits that the asserted combination lacks the requisite motivation to combine.

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Moreover, the Dean reference teaches away from the Office Action's proposed modification. The Office Action appears to propose using the Chari reference's contention circuitry at the star coupler to detect collisions using the pilot signals of Dean. Applicant submits that the Dean reference teaches that the collision detection circuitry is at each MAU. More specifically, the Dean reference teaches that each receiver has access to its own pilot source permitting synchronous demodulation of the returning pilot signal (see Col. 3, lines 11-15). Thus, the Dean reference teaches away from the detection circuitry of the Chari reference, which is located at the star coupler rather than at each MAU. In view of the aforementioned argument, claims 1 and 9 should be in a condition for allowance. Accordingly, Applicant requests that the rejections of claims 1 and 9 be withdrawn.

With regard to claims 2-6, Applicant submits that claims 2-6 depend from claim 1, and thus, necessarily contain all the limitations of the claim from which they depend. In view of the aforementioned argument, claim 1 should be in a condition for allowance. Accordingly, Applicant requests that the rejections of claims 2-6 be withdrawn.

Regarding the indication of allowance of claims 7 and 8, Applicant appreciates the indication of allowability if rewritten in independent form. In view of the preceding arguments, Applicant submits that claims 7 and 8 should be in a condition for allowance because the claims that they depend from should be in a condition for allowance. Accordingly, Applicant requests that the objections of claims 7 and 8 be removed.

Without correspondence for each and every claimed limitation the rejections are improper. Accordingly, Applicant requests that the rejections of claims 1-9 be withdrawn.

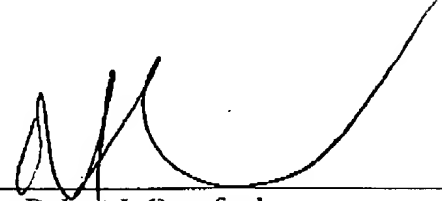
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In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney overseeing the application file, Kevin Fortin, Esq., of NXP Corporation at (408) 474-9071.

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 
Name: Robert J. Crawford
Reg. No.: 32,122
(NXPS.219PA)